

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN G. SAVAGE,
SCOTT P. MACKENZIE, AND KENNETH A. NICOLL

Appeal 2007-0448
Application 09/433,139
Technology Center 2100

Decided: August 21, 2007

Before JOSEPH F. RUGGIERO, LANCE LEONARD BARRY,
and MAHSHID D. SAADAT *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 36-40. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal relates to automated teller machines ("ATMs"). An ATM can dispense cash from a safe to a customer. It can also dispense paper receipts and statements. The ATM's printer, however, requires regular maintenance, and its consumables (e.g., paper, ink, ribbon, cartridges) require periodic replenishment. The paper receipts and statements are also liable to be lost or discarded unwittingly by the recipient. (Specification 1.)

In contrast, the Appellants' invention transmits data from an ATM to a customer's portable device, without the need to print the data onto a paper receipt. This enables a customer to obtain receipts in electronic form directly from an ATM and to store the receipts onto the device. (*Id.* 2.)

B. ILLUSTRATIVE CLAIM

Claim 36, which further illustrates the invention, follows.

36. A method of operating an automated teller machine (ATM) when an ATM customer uses a portable device retained by the ATM customer to conduct an ATM cash dispense transaction to obtain cash, the method comprising:

establishing wireless communication with the portable device retained by the ATM customer;

executing the ATM cash dispense transaction;

dispensing cash to the ATM customer when the ATM cash dispense transaction is executed;

preparing data relating to the ATM cash dispense transaction that has been executed;

transferring the prepared data to the portable device retained by the ATM customer via the wireless communication to provide the ATM customer with an electronic receipt for the ATM cash dispense transaction;

receiving from the portable device retained by the ATM customer personal information which is unrelated to the ATM cash dispense transaction and which is associated with the ATM customer when the electronic receipt is provided to the ATM customer; and

downloading to the portable device retained by the ATM customer specific information which is unrelated to the ATM cash dispense transaction and which is tailored to the ATM customer based upon the received personal information from the portable device retained by the ATM customer.

C. REJECTION

Claims 36-40 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,334,109 ("Kanevsky") and U.S. Patent No. 6,431,439 ("Suer").

II. FINDINGS OF FACT

Kanevsky "produc[es] an advertisement that is personalized to a particular user for a current transaction and is presented to such user at the point of sale or transaction terminal." (Abs. ll. 1-4.) "The personalized advertisement may be communicated to the particular user by using printers or displays associated with the transaction terminal that generates the current transaction." (Col. 1, ll. 11-14.) More specifically, "[t]he personalized

advertisement is presented to the particular user on a sales receipt or on a display." (Col. 8, ll. 39-40.) For example, "PC 109 may be equipped with a home shopping software that enables a particular user to obtain a personalized advertisement to be displayed on the PC screen. . . ." (Col. 7, ll. 1-3.)

For its part, Suer describes "a portable, hand-held information storage and transmission device 10 . . . that may be connected to a plurality of remote terminal units, such as an automatic teller machine (ATM) 20, a host PC 30, and a point-of-sale terminal 40 located at a merchant's site." (Col. 6, ll. 38-43.) "The portable, hand-held device may also be referred to as an information storage device. The device 10 may communicate various financial transaction data to and receive similar data from each of these terminal units." (*Id.* ll. 44-47.)

For example, a "user may enter ATM transaction information, such as a personal identification number (PIN) and a transaction amount, into the device 10 and transmit the information from the device 10 to the ATM 20 so that the user may perform ATM functions (e.g., withdraw money, transfer money between accounts, and deposit money) using the device 10." (*Id.* ll. 49-55.) The associated financial institution "may then execute the financial transaction based on the information transmitted to it and provide the merchant and the Information Storage Device with an electronic receipt of the financial transaction." (Col. 12, ll. 42-45.)

III. ISSUE

"Rather than reiterate the positions of parties *in toto*, we focus on the issue therebetween." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (B.P.A.I. 2007). The Examiner makes the following findings.

At the time the invention was made, one of ordinary skill in the art would have readily recognized the desirability and advantages of modifying Kanevsky by employing the provision of personalized information to the user of an ATM via a portable device. This benefits the system because the user of an ATM may be in need of information relating to the area of the machine. Further, the system will address a larger number of users by branching out to ATMs in addition to other points of sale while the user may save the information to the portable device.

(Answer 4.) The Appellants argue, "If Kanevsky were modified in view of Suer, a feature claimed by the invention of Kanevsky (i.e., the printing of personal advertisement on a sales receipt) would be destroyed since modified Kanevsky would result in paperless financial transactions." (Br. 5.) Therefore, the issue is whether the Appellants have shown that combining Suer's teaching of an electronic receipt with Kanevsky would have rendered the latter reference inoperable for its intended purpose.

IV. PRINCIPLES OF LAW

The presence or absence of a reason "to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). The U.S. Court of Appeals for the Federal Circuit "has previously found a

proposed modification inappropriate for an obviousness inquiry when the modification rendered the prior art reference inoperable for its intended purpose." *In re Fritch*, 972 F.2d 1260, 1266 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

V. ANALYSIS

Here, contrary to the Appellants' argument, printing its personalized advertisement on a paper receipt is not an intended purpose of Kanevsky. Although the personalized advertisement may be "presented to the particular user on a sales receipt," (col. 8, ll. 39-40), the reference explains that "[a] different kind of advertisement presentation can be done for devices that have displays, like PC 109 and telephone 120." (Col. 6, l. 66 – Col. 7, l. 1.) In the case of the PC, for example, the personalized advertisement is "displayed on the PC screen. . . ." (Col. 7, l. 3.) Because Suer's portable, hand-held device includes "a liquid it [sic] crystal display (LCD)," (col. 7, l. 51,) we find that the combination of Kanevsky and Suer would have displayed the personalized advertisements on the LCD display.

Not only is printing its personalized advertisement on a paper receipt not an intended purpose of Kanevsky, we agree with the Examiner that "the addition of a paperless display is one of the objects of the invention (col. 1, lines 54-55)." (Answer 6.) More specifically, "an[] object of the . . . invention is to provide a system and method for using devices with displays for distributing personalized advertisements." (Col. 1, ll. 54-55.) Because

distributing personalized advertisements via devices with displays is one of the objects of Kanevsky, we find that combining Suer's teaching of an electronic receipt with Kanevsky would have rendered the latter reference operable for the intended purpose of adding a paperless display.

VI. CONCLUSION

For the aforementioned reasons, the Appellants have failed to show that combining Suer's teaching of an electronic receipt with Kanevsky would have rendered the latter reference inoperable for its intended purpose.

VII. ORDER

Therefore, we affirm the rejection of claims 36-40 under § 103(a).

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the Appellants' Brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

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No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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